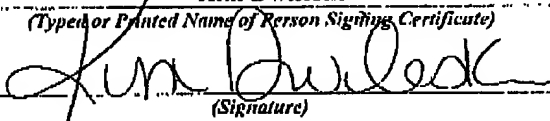


SEP 07 2005

CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)			Docket No. RSW920010064US1
Applicant(s): Bredow et al.			
Application No. 09/845,542	Filing Date 4/30/01	Examiner Endok, Mark A.	Group Art Unit 3625
Invention: METHOD OF DISPLAYING A SHOPPING SUMMARY TO A SHOPPER WHO ACCESSES AN ELECTRONIC COMMERCE WEB SITE			
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<p>Note: Each paper must have its own certificate of mailing.</p>			

SEP 07 2005

DOCKET NO. RSW920010064US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bredow *et al.*

Examiner: Fadok, Mark A.

Serial No.: 09/845,542

Art Unit: 3625

Filed: 4/30/01

For: **METHOD OF DISPLAYING A SHOPPING SUMMARY TO A SHOPPER WHO
ACCESSES AN ELECTRONIC COMMERCE WEB SITE**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF OF APPELLANT

This Reply Brief addresses issues raised in the Examiner's Answer mailed July 8, 2005.

GROUND OF REJECTION 1

Claims 1-21 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Sherr et al. (US 20020154157) in view of Official Notice.

Claim 1

In discussing the feature "showing a shopping summary in response to detecting the right click" of claim 1, the Examiner's Answer acknowledges that "Sherr teaches displaying an order page initiated by a right mouse click (page 7, para 071), but does not specifically mention showing a shopping summary in response to detecting the right click."

The Examiner's Answer argues: "It would have been obvious to a person having ordinary

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skill in the art at the time of the invention to include in Sherr, a shopping summary as claimed in the instant invention, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option. Offering this flexibility would increase the sale and use of the system and thus create increased revenue for the company by satisfying the needs of the customer."

In Reply, Appellants respectfully contend that the statement in the Examiner's Answer that "this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option" is vague and indefinite, and reflects unsupported speculation by the Examiner's Answer.

The Examiner's Answer alleges that the preceding argument by the Examiner is supported by the helpcommunity article ("Adding Mouse Right-Click Functionality").

In Reply, Appellants note that the "helpcommunity article" merely provides instructions on how to add a right-click functionality to software and does not include any support for the argument in the Examiner's Answer as to why it is allegedly obvious to perform the step of "showing a shopping summary in response to detecting the right click". In fact, Appellants respectfully contend that the "helpcommunity article" has no relevance as to whether claim 1 is unpatentable over Sherr in view of Official Notice. The issue is not whether a right-click functionality could be used with software. The issue is whether it is obvious to perform the step of "showing a shopping summary in response to detecting the right click".

As to the use of Official Notice in the Examiner's Answer to modify Sherr with respect to

the preceding feature of claim 1, Appellants have repeatedly challenged the Examiner, under MPEP 2144.03C, to provide adequate evidence to support the following statement in the Examiner's Answer : "It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, a shopping summary as claimed in the instant invention, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option." Appellants contend that the inability of the Examiner's Answer to produce a prior art reference in support of the argument in the Examiner's Answer further demonstrates that the argument in the Examiner's Answer is not persuasive.

Appellants respectfully contend that the following statement in the Examiner's Answer of: "offering this flexibility would increase the sale and use of the system and thus create increased revenue for the company by satisfying the needs of the customer" reflects unsupported speculation by the Examiner and is not disclosed in the prior art. Appellants reiterate that Appellants' prior challenge of the Examiner, under MPEP 2144.03C, to provide adequate evidence to support the preceding statement of the Examiner was not adequately responded to by the Examiner's Answer. An argument based solely on the Examiner's hindsight reasoning, without evidentiary support from the prior art, is not persuasive.

The Examiner's Answer also argues "In regards to claim 1, and applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either

in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner has stated reasoning from knowledge generally available to one of ordinary skill in the art.”

In Reply, Appellants contend that the only evidence that the Examiner’s Answer has presented of knowledge generally available to one of ordinary skill in the art is the “helpcommunity article” which merely provides instructions on how to add a right-click functionality to software and does not include any support for the argument in the Examiner’s Answer as to why it is allegedly obvious to perform the step of “showing a shopping summary in response to detecting the right click”.

The Examiner’s Answer also argues: “It is noted that the examiner considers the many different results of the manipulative step of right clicking (i.e. bidding summaries, shopping carts, overlays etc.) to be non-functional language and therefore these resultant effects are given little patentable weight because they do not perform a manipulative step. Sherr teaches in paragraphs 71, 85 and 95 that the use of the right click can open an order screen or a display. As is contemplated by Sherr, a plurality of programmed displays may be adapted to be presented by the right click button of mouse without changing the manipulative step of pressing the right click button.”

In Reply, Appellants contend that the Examiner’s Answer has incorrectly interpreted claim 1 as allegedly claiming “the manipulative step of right clicking” which is allegedly non-functional language. Appellants contend that the manipulative step of right clicking a mouse

is not claimed in claim 1. Indeed, claim 1 claims detecting a right click, but claim 1 does not claim the manipulative step of performing a right click as alleged by the Examiner's Answer. Thus, the preceding argument in the Examiner's Answer is based on a wrong interpretation of the language of claim 1 and is accordingly not persuasive.

As a matter of fact, claim 1 recites the manipulative step of "showing a shopping summary in response to detecting the right click" that is responsive to the manipulative step of "detecting a right click of a computer mouse on a web page". Thus, claim 1 recites cause and effect between the manipulative "detecting" step and the manipulative "showing" step. Both the "detecting" step and the "showing" step have patentable weight. The feature of "in response to detecting a right click" is the cause and effect link between the "detecting" step and the "showing" step and therefore likewise has patentable weight.

In addition the Examiner's Answer argues:

"The examiner, however, further clarifies Sherr's motivation by providing the following statements from Sherr.

"...and a right click which may be used to enter an "order" page to rent the movie (either directly or through a pop-up menu)." (para 0071)

"A user may interact with the display representations of content items presented on the Browse page in the same way as content item representations on the home page, for example, by selecting a content item (for example, movie) with a left or right click to view more information or purchase or obtain a license to access the selected content item, respectively." (para 0085)

It is clear from the passages that Sherr intended the use of the "right click" option for a plurality of displays. Further, Sherr does present reasons for modification such as in

paragraph 7: "The success of a content service on the Internet may depend, at least in part, on the ease by which a user may select and access content. Services that provide websites having formats or displays that are unfamiliar or complicated to typical users may have difficulty in attracting a sufficient number of users to the website and generating repeat users. Thus, there is a demand for user interfaces, such as websites, which are easy to operate and provide familiar or recognizable formats." (para 007)"

In Reply, Appellants note that the preceding citation to Paragraph 0007 of Sherr in the Examiner's Answer is misdirected because Paragraph 0007 of Sherr is in Sherr's "Background Section" and is not disclosed in Sherr as having any relationship to Sherr's invention in Paragraphs 0071 and 0085. Moreover, Paragraph 0007 of Sherr relates the success of a content service on the Internet to whether the provided websites are familiar and uncomplicated. Paragraph 0007 of Sherr does not relate the success of a content service on the Internet to a manner of clicking a mouse. Therefore, the preceding argument in the Examiner's Answer is additionally misdirected.

With respect to motivation, Appellants reiterate that the Examiner's Answer has not provided any evidence from the prior art reference showing motivation for "showing a shopping display in response to detecting the right click". The arguments presented in the Examiner's Answer, based solely on the Examiner's hindsight reasoning without evidentiary support from the prior art, are not persuasive.

Based on the preceding arguments, Appellants respectfully maintain that claim 1 is not unpatentable over Sherr in view of Official Notice, and that claim 1 is in condition for allowance.

Claim 4

Appellants respectfully contend that claim 4 is not unpatentable over Sherr in view of Official Notice, because Sherr in view of Official Notice does not teach or suggest the feature: "showing a shopping cart responsive to detecting the right click of the computer mouse on the on-line shopping web page".

The Examiner's Answer states: "see response to claim 1, and FIG 14". In Reply, Appellants cite Appellants' arguments relating to claim 1.

In addition, Appellants respectfully contend that FIG. 14 of Sherr depicts an "open order ticket page" (see Sherr, paragraph 0105, lines 1-3) which is not a "shopping cart". A "shopping cart" comprises a list of goods to be purchased (see Appellants' specification, page 1, lines 14-17). In contrast, an "open order ticket page" comprises a list of goods previously purchased (see Sherr, paragraph 0105, lines 1-8). Therefore, the Examiner's citation of FIG. 14 of Sherr is not persuasive and the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 4.

The Examiner's Answer also argues: "In regards to claim 4, appellant argues that the open order ticket page is not a "shopping cart". It is noted that the examiner considers the many different results of the manipulative step of right clicking (i.e. bidding summaries, shopping carts, overlays etc.) to be non-functional language and therefore these resultant effects are given little patentable weight because they do not perform a manipulative step. However, Sherr teaches

in paragraphs 0071,0085 and 0095 that the use of the right click can open an order screen or a display. As is contemplated by Sherr, a plurality or programmed displays may be adapted to be presented by the right click button of the mouse without changing the manipulative step of pressing the right click button. Furthermore, the appellant has defined a shopping cart as "comprising a list of goods to be purchased", therefore, by definition this is also a "shopping summary" and was previously addressed in claim 1."

In Reply, Appellants contend that the Examiner's Answer has incorrectly interpreted claim 4 as allegedly claiming "the manipulative step of right clicking" which is allegedly non-functional language. Appellants contend that the step of right clicking a mouse is not claimed in claim 4. Indeed, claim 4 claims detecting a right click, but claim 4 does not claim performing a right click as alleged by the Examiner's Answer. Thus, the preceding argument by the Examiner is based on a wrong interpretation of the language of claim 4 and is accordingly not persuasive.

As a matter of fact, claim 4 recites the manipulative step of "showing a shopping cart response to detecting the right click" that is responsive to the manipulative step of "detecting a right click of a computer mouse on an on-line shopping web page". Thus, claim 4 recites cause and effect between the manipulative "detecting" step and the manipulative "showing" step. Both the "detecting" step and the "showing" step have patentable weight. The feature of "in response to detecting a right click" is the cause and effect link between the "detecting" step and the "showing" step and therefore likewise has patentable weight.

Based on the preceding arguments, Appellants respectfully maintain that claim 4 is not unpatentable over Sherr in view of Official Notice, and that claim 4 is in condition for allowance.

Claim 7

Appellants respectfully contend that claim 7 is not unpatentable over Sherr in view of Official Notice, because Sherr in view of Official Notice does not teach or suggest the feature: "showing a bidding summary responsive to detecting the right click of the computer mouse on the on-line auction web page".

The Examiner's Answer argues: "Sherr teaches displaying an order page initiated by a right mouse click (page 7, para 071), but does not specifically mention showing a bidding summary in response to detecting the right click. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, displaying bidding summaries as claimed in the instant application, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option. Offering this flexibility would increase the sale and use of the system and thus create increased revenue due to satisfying the needs of the customer."

In Reply, Appellants respectfully contend that the Examiner's Answer has not identified even a single reference pertaining to an "on-line auction web page" and a "bidding summary" and has therefore failed to establish a *prima facie* case of obviousness in relation to claim 7.

The Examiner's Answer argues: "In regards to claim 7, appellant argues that the examiner has not provided a reference that shows the right click being used to show a "bidding summary". The examiner disagrees and notes that as stated in response to claim 4, the examiner considers the many different results of the manipulative step of right clicking (i.e. bidding summaries, shopping carts, overlays etc.) to be non-functional language and therefore these resultant effects are given little patentable weight because they do not perform a manipulative step. Sherr teaches in paragraphs 0071, 0085 and 0095 that the use of the right click can open an order screen or a display. As is contemplated by Sherr, a plurality or programmed displays may be adapted to be presented by the right click button of the mouse without changing the manipulative step of pressing the right click button. The examiner also provided as evidentiary support the "help community web page" that shows programmers how to program the right click option actuation of any number of information displays. Since the use of the right click was widely known to one of ordinary skill in the art at the time of the invention to present any type of display, the examiner does not consider any particular one of the infinite number of displays that could be displayed as carrying any particular patentable weight. Furthermore, appellant has not disclosed that limiting the invention to the use of only those stated displays of the instant claims solves any particular problem or is for any particular purpose and it appears that the invention would perform equally well with any type of displayed information. In response to the other arguments the examiner refers the appellant to the previous discussion in claims 1-6."

In Reply, Appellants contend that the Examiner's Answer has incorrectly interpreted claim 7 as allegedly claiming "the manipulative step of right clicking" which is allegedly

non-functional language. Appellants contend that the step of right clicking a mouse is not claimed in claim 4. Indeed, claim 7 claims detecting a right click, but claim 7 does not claim performing a right click as alleged by the Examiner's Answer. Thus, the preceding argument by the Examiner is based on a wrong interpretation of the language of claim 7 and is accordingly not persuasive.

As a matter of fact, claim 7 recites the manipulative step of "showing a bidding summary response to detecting the right click" that is responsive to the manipulative step of "detecting a right click of a computer mouse on an on-line auction page". Thus, claim 7 recites cause and effect between the manipulative "detecting" step and the manipulative "showing" step. Both the "detecting" step and the "showing" step have patentable weight. The feature of "in response to detecting a right click" is the cause and effect link between the "detecting" step and the "showing" step and therefore likewise has patentable weight.

In addition, Appellants respectfully contend the following argument in the Examiner's Answer is not persuasive: "Since the use of the right click was widely known to one of ordinary skill in the art at the time of the invention to present any type of display, the examiner does not consider any particular one of the infinite number of displays that could be displayed as carrying any particular patentable weight".

In Reply, Appellants contend that the Examiner's Answer has not presented any prior art suggesting that the right click should be used to present any type of display. The Examiner's Answer has presented only the reference of Sherr which suggests the use of a right click for only particular type of displays.

In addition, Appellants respectfully contend the following argument in the Examiner's Answer is not persuasive: "appellant has not disclosed that limiting the invention to the use of only those stated displays of the instant claims solves any particular problem or is for any particular purpose ..."

In Reply, Appellants refer to the preceding allegation of lack of utility in the Examiner's Answer is pertinent to 35 U.S.C. §101 which not at issue in this appeal. Nonetheless, the present invention does not lack utility. Appellants refer to Appellants' specification as follows:

"Thus there is a need for a more convenient way of providing shopping summaries that may be accessed easily by e-commerce customers, for example shopping carts and similar summaries of barter, rental, leasing, and auction activities, in order to provide the customer with a more convenient on-line experience, and to open the use of e-commerce to a wider spectrum of the population." (Specification, page 2, lines 12-16); and

"Thus the present invention enables the customer to show and to retire the shopping summary at will by entering a computer mouse right-click." (Specification, page 2, lines 12-16).

Appellants reiterate that the Examiner's Answer has not identified even a single reference pertaining to an "on-line auction web page" and a "bidding summary" and has therefore failed to establish a *prima facie* case of obviousness in relation to claim 7.

Based on the preceding arguments, Appellants respectfully maintain that claim 7 is not

unpatentable over Sherr in view of Official Notice, and that claim 7 is in condition for allowance.

Claim 10

Appellants respectfully contend that claim 10 is not unpatentable over Sherr in view of Official Notice, because Sherr in view of Official Notice does not teach or suggest the feature: "deriving a screen location from screen coordinates of the computer mouse; creating an overlay that includes a shopping summary; and showing the overlay upon the web page at the derived location."

The Examiner's Answer argues: "Sherr discloses a method of presenting a shopping summary for electronic commerce, comprising the acts of: detecting a right click of a computer mouse on a web page (page 7, para 071); deriving a screen location from screen coordinates of the computer mouse (page 6, para 0067); creating an overlay that includes a shopping summary (FIG 2, item 206); and showing the overlay upon the web page at the derived location (FIG 2, item 206)".

The Examiner's Answer additionally argues: "In regards to claim 10, appellant argues that Sherr does not teach locating a site with a mouse and activating another window at the derived location. The examiner disagrees and directs the appellant's attention to cited para 0067 that locates the cursor (activated by a mouse) placed on an image and activates the image. The examiner further directs the appellant's attention to para 0066 where a selected location defined by a selected area presents another active webpage in the activated location. The examiner also notes that it was notoriously well known to activate a window (such as a pull down menu, see

pop up menu para 0071) in a location designated by a mouse and activated by a click of the mouse. In regards to the remaining arguments the examiner directs the appellant's attention to the response to claims 1-9 above."

In Reply, Appellants contend that Sherr, Pars. 0066-0067 does not support the Examiner's allegation that Sherr in view of Official Notice teaches or suggests the feature "deriving a screen location from screen coordinates of the computer mouse; creating an overlay that includes a shopping summary; and showing the overlay upon the web page at the derived location". Appellants respectfully contend that streaming box 206 in FIG. 2 of Sherr does not include a shopping summary, as required by claim 10.

In further Reply, Appellants contend that the Examiner's argument is inconsistent with the antecedent basis requirements of claim 10, because the streaming box 206 in FIG. 2 of Sherr is not positioned at the same screen location referred to in Sherr, Pars. 0066-0067. In particular, "the derived location" in the phrase "showing the overlay upon the web page at the derived location" has antecedent basis in "deriving a screen location from screen coordinates of the computer mouse". From the preceding antecedent basis considerations, the streaming box 206 in FIG. 2 of Sherr must be positioned at the same screen location referred to in Sherr, Pars. 0066-0067. However, Sherr does not disclose any relationship between the streaming box 206 in FIG. 2 of Sherr and Sherr, Pars. 0066-0067. Accordingly, Appellants maintain that the argument in the Examiner's Answer is logically inconsistent.

Based on the preceding arguments, Appellants respectfully maintain that claim 10 is not

unpatentable over Sherr in view of Official Notice, and that claim 10 is in condition for allowance.

Claims 11-14

With respect to claims 11-14, Sherr does not teach or suggest: "wherein the shopping summary includes a shopping cart" (claim 11), "wherein the shopping summary includes an auction-bid summary" (claim 12), "wherein the shopping summary includes a barter summary" (claim 13), and "wherein the shopping summary includes a rental summary" (claim 14).

The Examiner's Answer argues: "In regards to claims 11-15, Sherr teaches displaying an order page initiated by a right mouse click (page 7, para 071), but does not specifically mention showing all the different summaries in response to detecting the right click. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, displaying summaries as claimed in the instant invention, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option. Offering this flexibility would increase the sale and use of the system and thus create increased revenue by satisfying the needs of the customer."

In Reply, Appellants respectfully contend that the Examiner's statement that "this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option" is vague and indefinite, and reflects unsupported speculation in the Examiner's Answer, as explained *supra* in

conjunction with claim 1.

In further Reply, Appellants respectfully contend that the Examiner's statement of: "offering this flexibility would increase the sale and use of the system and thus create increased revenue for the company by satisfying the needs of the customer" reflects unsupported speculation in the Examiner's Answer and is not disclosed in the prior art. The preceding argument, based solely on the Examiner's hindsight reasoning without evidentiary support from the prior art, is not persuasive.

The Examiner's Answer states: "In response to appellant's arguments concerning claims 11-14, the examiner directs appellant's attention to the response to claims 7-9 above."

In Reply, Appellant refer to Appellants' arguments *supra* in relation to claim 7.

In addition, Appellants reiterate that the argument in the Examiner's Answer that "the examiner considers the many different results of the manipulative step of right clicking (i.e. bidding summaries, shopping carts, overlays etc.) to be non-functional language and therefore these resultant effects are given little patentable weight because they do not perform a manipulative step" is based on an incorrect claim construction in the Examiner's Answer with respect to the claim language of claims 11-14 as explained *supra* in conjunction with claims 1, 4, and 7.

In addition, Appellants note that the Examiner's Answer has not identified any reference relating to an auction-bid summary, a barter summary, a rental summary. By not providing any such reference, the Examiner has not established a *prima facie* case of obviousness in relation to

claims 12-14.

Moreover, Appellants respectfully contend that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Sherr by the Examiner's unsupported allegation of Official Notice in relation to claims 11-14. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the motivation obvious unless the prior art suggested the desirability of the modification."). The Examiner has not made any showing of where the prior art suggests: "wherein the shopping summary includes a shopping cart" (claim 11), "wherein the shopping summary includes an auction-bid summary" (claim 12), "wherein the shopping summary includes a barter summary" (claim 13), and "wherein the shopping summary includes a rental summary" (claim 14)". Thus, the Examiner has provided a reason for the modification of Sherr by the Examiner's speculation using hindsight reconstruction in conjunction with the Examiner's personal opinion, and not by teachings of the prior art. By not citing any suggestion or incentive in the prior art for: "wherein the shopping summary includes a shopping cart" (claim 11),

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“wherein the shopping summary includes an auction-bid summary” (claim 12), “wherein the shopping summary includes a barter summary” (claim 13), and “wherein the shopping summary includes a rental summary” (claim 14)”, the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 11-14.

Claim 15

Appellants respectfully contend that claim 15 is not unpatentable over Sherr in view of Official Notice, because Sherr in view of Official Notice does not teach or suggest the feature: “when the right click is detected, determining whether a shopping summary is shown.” The Office Action dated November 19, 2004 does not even allege that Sherr discloses said “determining” feature of claim 15. The Examiner’s Answer likewise does not address said “determining” feature of claim 15. Thus, the Examiner has not established a *prima facie* case of obviousness in relation to claim 15.

Moreover, Sherr in view of Official Notice does not teach or suggest the feature: “if the shopping summary is shown upon detection of the right click, retiring the shopping summary, and if the shopping summary is not shown upon detection of the right click, showing the shopping summary.”

The Examiner argues: “In response to claim 15, Sherr discloses using the right click of a mouse to perform a limited programmed function such as entering an order page within a current webpage (see response to claims 1-14), but does not specifically mention that the right click is

used to open and close an application such as a shopping summary. Turning programs on and off utilizing a single on/off switch activation mechanism such as a mouse click is old and well known in the art. It would have been obvious to a person having ordinary skill in the art to change the right click programming to include on/off capability, because this would improve the system of Sherr by turning off a program that was activated with the right click and removing information that was not currently needed thus creating a less cluttered webpage."

In Reply, Appellants assert that Sherr does not disclose a "shopping summary" and Appellants cite Appellants' arguments relating to claims 1 and 4.

In further Reply, the Examiner's Answer admits that Sherr does not disclose the decision logic in claim 15 of: "if the shopping summary is shown upon detection of the right click, retiring the shopping summary; and if the shopping summary is not shown upon detection of the right click, showing the shopping summary".

With respect to the preceding decision logic feature of claim 15, the Examiner's Answer argues:

"...and a right click which may be used to enter an "order" page to rent the movie (either directly or through a pop-up menu)." (para 0071)

"A user may interact with the display representations of content items presented on the Browse page in the same way as content item representations on the home page, for example, by selecting a content item (for example, movie) with a left or right click to view more information or purchase or obtain a license to access the selected content item, respectively." (para 0085).

It is clear from the passages that Sherr intended the use of the "right click" option for a plurality of displays. Further, Sherr does present reasons for modification such as in paragraph 7: "The success of a content service on the Internet may depend, at least in part, on the ease by

which a user may select and access content. Services that provide websites having formats or displays that are unfamiliar or complicated to typical users may have difficulty in attracting a sufficient number of users to the website and generating repeat users. Thus, there is a demand for user interfaces, such as websites, which are easy to operate and provide familiar or recognizable formats." (007). Sherr would be further motivated to turn off the image once activated because viewing box 206 would need to be available should another image or action be selected."

In Reply, Appellants note that the preceding citation to Paragraph 0007 of Sherr in the Examiner's Answer is misdirected because Paragraph 0007 of Sherr is in Sherr's "Background Section" and is not disclosed in Sherr as having any relationship to Sherr's invention in Paragraphs 0071 and 0085. Moreover, Paragraph 0007 of Sherr relates the success of a content service on the Internet to whether the provided websites are familiar and uncomplicated. Paragraph 0007 of Sherr does not relate the success of a content service on the Internet to a manner of clicking a mouse. Therefore, the preceding argument in the Examiner's Answer is additionally misdirected.

In summary, the preceding feature of claim 15 is using the right click of a mouse as a toggle switch for turning on and off a display of a shopping summary, which is not taught or suggested in the prior art. The arguments presented in the Examiner's Answer, based solely on the Examiner's hindsight reasoning without evidentiary support from the prior art, are not persuasive.

Claims 18-21

With respect to claims 18-21, Sherr does not teach or suggest: "wherein the shopping

summary includes a shopping cart" (claim 18), "wherein the shopping summary includes an auction-bid summary" (claim 19), " wherein the shopping summary includes a barter summary" (claim 20), and "wherein the shopping summary includes a rental summary" (claim 21)".

The Examiner states: "In regards to appellant's arguments concerning claims 18-21, the examiner directs the appellant's attention to claims 7-9".

In Reply, Appellant refer to Appellants' arguments *supra* in relation to claim 7.

In addition, Appellants reiterate that the argument in the Examiner's Answer that "the examiner considers the many different results of the manipulative step of right clicking (i.e. bidding summaries, shopping carts, overlays etc.) to be non-functional language and therefore these resultant effects are given little patentable weight because they do not perform a manipulative step" is based on an incorrect claim construction in the Examiner's Answer with respect to the claim language of claims 18-21, as explained *supra* in conjunction with claims 1, 4, and 7.

In addition, Appellants note that the Examiner's Answer has not identified any reference relating to an auction-bid summary, a barter summary, a rental summary. By not providing any such reference, the Examiner has not established a *prima facie* case of obviousness in relation to claims 19-21.

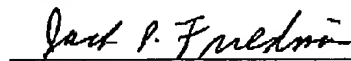
Moreover, Appellants respectfully contend that the Examiner's Answer has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Sherr by the Examiner's unsupported allegation of Official Notice in relation to claims 18-21. In particular, established case law requires that the prior art must contain some suggestion or

incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the motivation obvious unless the prior art suggested the desirability of the modification."). The Examiner has not made any showing of where the prior art suggests: "wherein the shopping summary includes a shopping cart" (claim 18), "wherein the shopping summary includes an auction-bid summary" (claim 19), "wherein the shopping summary includes a barter summary" (claim 20), and "wherein the shopping summary includes a rental summary" (claim 21)". Thus, the Examiner has provided a reason for the modification of Sherr by the Examiner's speculation using hindsight reconstruction in conjunction with the Examiner's personal opinion, and not by teachings of the prior art. By not citing any suggestion or incentive in the prior art for: "wherein the shopping summary includes a shopping cart" (claim 18), "wherein the shopping summary includes an auction-bid summary" (claim 19), "wherein the shopping summary includes a barter summary" (claim 20), and "wherein the shopping summary includes a rental summary" (claim 21)", the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 18-21.

SUMMARY

In summary, Appellant respectfully requests reversal of the November 19, 2004 Office Action rejection of claims 1-21.

Respectfully submitted,



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